

No. 16858 ✓

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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JAYBEE MANUFACTURING CORPORATION,

*Appellant,*

*vs.*

AJAX HARDWARE MANUFACTURING CORPORATION,

*Appellee.*

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## APPELLANT'S BRIEF.

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## APPELLANT'S BRIEF.

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### STATEMENT OF JURISDICTION.

This action was instituted by plaintiff Ajax Hardware Manufacturing Corporation for infringement of a design patent, No. Des. 182,602. The complaint appears at page 3 of the record. The jurisdiction of the District Court was invoked under Title 35, Patents, of the United States Code and is further supported by §1338 of Title 28 of the United States Code. The answer of defendant Jaybee Manufacturing Corporation is set forth at page 7 of the record. The answer places in issue the questions of validity and infringement. The answer contains a counterclaim for declaratory relief [R. 9] seeking a declaration that the plaintiff's patent No. Des. 182,602 is invalid and not infringed. The jurisdiction of the Dis-

trict Court was invoked under §2201 and §2202 of Title 28 of the United States Code and is further supported by §1338 of Title 28 of the United States Code.

Plaintiff's answer to the counterclaim [R. 14] denied the allegations of invalidity and non-infringement but admitted the issuance of threatening letters such as Exhibits N-1 and N-2 [R. 51-52].

The action was tried on the issues framed by the Complaint for Infringement of United States Letters Patent No. Des. 182,602 [R. 3], Answer containing Counterclaim for Declaratory Judgment [R. 9] and Answer to Counterclaim [R. 14]. The District Court made its own findings of fact, conclusions of law and judgment [R. 30]. The judgment dismissing both the complaint and the counterclaim [R. 32] was entered on February 16, 1960, as evidenced by the notice of entry of judgment [R. 33]. A notice of appeal was timely filed on March 17, 1960 [R. 34].

This Court has jurisdiction of this appeal pursuant to §1291 and §1292(4) of Title 28 of the United States Code.

#### STATEMENT OF THE CASE.

The findings of fact, conclusions of law and judgment [R. 30-32] of the District Court hold the design patent in suit valid but not infringed. This appeal has two facets.

The first has to do with the District Court's dismissal of defendant's counterclaim for declaratory judgment. Inasmuch as the District Court found the patent not to be infringed, defendant-appellant through this appeal as-



serts its right to an injunction in order to prevent any additional threats of infringement suits by plaintiff against defendant's customers. By prosecuting the appeal on this point, the defendant hopes to preclude any multiplicity of litigation involving the particular devices accused of infringement. The issue is raised by the appeal from "that portion of the Judgment [which provides:] That defendant take nothing by reason of its counterclaim." and as set forth in the Notice of Appeal to Court of Appeals [R. 34].

The second facet of this case challenges the District Court's holding of validity and as embodied in the findings of fact and conclusions of law, and particularly Finding of Fact No. 2 [R. 30] and Conclusions of Law No. 2 [R. 32]. The issue is raised by the appeal "from that portion of the Findings of Fact, Conclusions of Law and Judgment . . . which find, conclude or adjudge that . . . Patent No. Des. 182,602 is valid.", and as set forth in the notice of appeal [R. 34]. This issue is also raised by the appeal from that portion of the judgment above quoted which dismisses the defendant's counterclaim, in that the counterclaim sought a declaration of invalidity of the patent in suit.

Although the devices accused of infringement were held not to infringe the patent, defendant-appellant is seriously concerned with the question of validity. Both parties are manufacturers of builders' hardware. Defendant-appellant naturally hopes to continue in business and add new items to its line. Plaintiff-appellee may believe

or be advised that such new items infringe the patent in suit. Unless this patent is now held invalid, defendant clearly runs the risk of further litigation based upon this patent which defendant believes should be held invalid. Defendant can ill-afford not to prosecute this appeal because the issue once finally decided will be binding. There is, of course, also a serious public interest involved when the validity of a patent is in question.

The question of validity will be decided upon a record of physical exhibits. The District Court in its memorandum decision [R. 17] conceded:

“The question of the validity of the design patent presents a much closer question from two standpoints—whether the design was anticipated by prior art and whether Leichter was the sole inventor, . . .”

The latter question is not involved in this appeal. Defendant-appellant will show that the District Court reached the wrong conclusion as to the issue of anticipation or lack of invention.

#### SPECIFICATION OF ERRORS.

1. The District Court erred in finding that United States Letters Patent No. Des. 182,602 was duly issued to plaintiff, as set forth in Finding of Fact No. 2 [R. 30].

2. Except for the exceptions therein noted, the District Court erred in finding that the allegations of defendant's Counterclaim are not true and as set forth in Finding of Fact No. 8 [R. 31].

3. The District Court erred in concluding that United States Letters Patent No. Des. 182,602 is valid and as set forth in its Conclusion of Law No. 2 [R. 32].

4. The District Court erred in concluding that defendant is entitled to no relief under the allegations of its Counterclaim and as set forth in its Conclusion of Law No. 4 [R. 32].

5. The District Court erred in holding that the defendant take nothing by reason of its counterclaim and as set forth in Paragraph 2 of its Judgment [R. 32].

#### SUMMARY OF ARGUMENT.

1. The suit for declaratory relief was properly brought.

2. Defendant Jaybee Manufacturing Corporation was entitled to relief under §2202 of Title 28 of the United States Code.

3. The question of validity is properly before this Court of Appeals.

4. The limited and incomplete record before the Patent Office Examiner resulted in improper allowance of the patent in suit.

5. The Examiner failed to find the most pertinent references.

6. Presumption of validity is non-existent.

7. Tests of invention are strict.

8. Commercial success does not weigh in favor of the patent.

9. Application of the rules negates patentability and compels a holding of invalidity.

## ARGUMENT.

### 1. The Suit for Declaratory Relief Was Properly Brought.

Defendant's Counterclaim alleges in Paragraph III [R. 10] that:

"This is a counterclaim for declaratory relief; and the jurisdiction of this court depends upon Section 2201 and 2202 of Chapter 151 of Title 28 of the United States Code; an actual controversy between defendant, Jaybee Manufacturing Corporation, and plaintiff Ajax Hardware Manufacturing Corporation, exists as to alleged infringement by defendant of United States Design Patent No. 182,602 issued on April 22, 1958. . . ."

Plaintiff's answer to counterclaim states in Paragraph 3 [R. 15]:

"Plaintiff admits the allegations contained in Paragraph III of said counterclaim."

Paragraph IV [R. 10] of defendant's Counterclaim states that:

"Plaintiff has issued notices to the trade and to customers of defendant that the said plaintiff intends to prosecute the customers of defendant under said Design Patent No. 182,602 because of resale by said customers of goods manufactured and sold by defendant . . . ."

That this is true, attention is invited to plaintiff's answer to counterclaim 4 [R. 15] which states that:

". . . plaintiff admits that it has issued notices to two customers of defendant as alleged in said Paragraph IV; . . . ."

It is well established that an action for declaratory judgment is properly brought by an alleged patent infringer once he or his customers is threatened with an infringement suit, and in order to determine whether the patent is infringed or not.

*Grip Nut Co. v. Sharp* (7th Cir., 1941), 124 F. 2d 814;

*Tremond Co. v. Schering Corporation* (3rd Cir., 1941), 122 F. 2d 702;

*Technical Tape Corp. v. Minnesota Mining & Mfg. Co.* (2nd Cir. 1952), 200 F. 2d 876;

*Massa v. Jiffy Products Co.* (9th Cir., 1957), 240 F. 2d 702.

In the *Jiffy Products Co.* case, this court, through Judge Orr stated, at page 705:

“Where the patent owner informs a customer of the alleged infringer that there is a violation of the owner’s patent by the alleged infringer’s manufacturing a certain item, there is sufficient controversy to allow the manufacturer to file suit . . .

“‘The fact that a patentee’s claim of infringement is a condition precedent of this type of action places the matter of adjudication of the patent within control of the patentee, for, if he wishes to avoid adjudication, he can refrain from making charges of infringement. But having made the charge, he then exposes himself to adjudication.’ Borchard, *Declaratory Judgments*, (1941), 807.”

2. Defendant Jaybee Manufacturing Corporation Was Entitled to Relief Under Section 2202 of Title 28 of the United States Code.

The defendant prayed [R. 13] that the court grant a final injunction enjoining and restraining plaintiff . . . from asserting, contending, claiming or alleging that the Design Patent No. 182,602 is or ever was infringed by defendant Jaybee Manufacturing Corporation or its customers, on account of the manufacture and sale by defendant or by the resale by its customers of the accused articles. The failure of the court to grant the injunction sought was clearly an error. The question is raised by Point on Appeal No. 5 [R. 35].

Section 2202 of Title 28 of the United States Code provides:

“Further necessary or proper relief based on a declaratory judgment or decree may be granted, after reasonable notice and hearing, against any adverse party whose rights have been determined by such judgment.”

Since the District Court properly found [R. 31] that the patent in suit was not infringed, it should have granted the injunction sought. Dismissing the counterclaim [R. 32] was error.

Attention is invited to the leading Supreme Court case of *Kessler v. Eldred*, 206 U. S. 285, 51 L. Ed. 1065. The plaintiff in that case brought suit to enjoin the owner of a patent from threatening suits, continuing suits or bringing suits against plaintiff's customers, and in view of the fact that the plaintiff had won an

adjudication to the effect that its cigar lighters did not infringe the patent owned by the defendant. Mr. Justice Moody stated:

“An action at law would be entirely inadequate to protect fully Kessler’s *unquestioned right*, and, under these circumstances, though there may be no exact precedent, we think that the jurisdiction in equity exists.” (Emphasis added.)

The subsequent passage of the declaratory judgment statute, and particularly §2202 solves the problem that concerned the court so far as equity jurisdiction was concerned. But attention is directed to the fact that the court pointed to an “*unquestioned right*” to an injunction where the patent was held not infringed.

Presumably the plaintiff here will argue that having lost its suit for infringement, it will naturally refrain from harassing any of the customers of the defendant Jaybee Manufacturing Corporation. Defendant simply desires, by virtue of this suit, an injunction to fortify such protestations. Furthermore, in this connection, attention is directed to *Vermont Structural Slate Co. v. Tatko Brothers Slate Co.* (2nd Cir., 1958), 253 F. 2d 29, wherein the court stated:

“. . . it is of little significance that defendant keeps insisting that it has no intention to harass plaintiff and its customers. Under the doctrine of *Kessler v. Eldred*, 206 U. S. 285, 27 S. Ct. 611, 51 L. Ed. 1065, plaintiff was entitled as of course to an injunction restraining Tatko, the unsuccessful patentee, and all persons claiming under the patent, from

bringing any action or otherwise threatening plaintiff on the basis of claims that there is interference with said patent by the use of pallets for the sale of slate to plaintiff's customers or purchasers, or by the use of said pallets in conjunction with plaintiff's business by any customer, user, purchaser or supplier of plaintiff, or in any way directly or indirectly using said patent to interfere with the business of plaintiff. If anything, the injunction as issued was too narrow in its scope, as it was not made applicable to the continued prosecution by defendant of an action already pending against one of plaintiff's customers in the United States District Court for Maine. There was ample residual power in the court to issue this permanent injunction, even though the original decree contained no such provision. 28 U. S. C. §2202; 6 Moore, Federal Practice (1953 ed., 1956 Supp.) §57.10."

Therefore, the District Court should have granted the injunction to which defendant is obviously entitled, and thereby avoid all possibilities of piecemeal litigation, however remote.

### 3. The Question of Validity Is Properly Before This Court of Appeals.

The District Court found in Finding of Fact No. 2 [R. 30]:

"On April 22, 1958, United States Letters Patent Des. No. 182,602 was duly issued. . . ."

The District Court concluded in its Conclusion of Law No. 2 [R. 32]:

"United States Letters Patent Des. No. 182,602 is valid."



Appellant's Points on Appeal No. 1 [R. 35] is that the District Court erred in finding in its Finding of Fact No. 2 that United States Letters Patent No. Des. 182,602 was duly issued. Point on Appeal No. 3 [R. 35] asserts that the District Court erred in concluding that United States Letters Patent No. Des. 182,602 is valid and as set forth in its Conclusion of Law No. 2.

Once it is decided what is and what is not prior art, the question of invention over that prior art is one of *law*.

In *Fritz W. Glitsch & Sons, Inc. v. Wyatt Metal & Boiler Works* (5th Cir., 1955), 224 F. 2d 331, the court stated at page 335:

“And while infringement is usually a question of fact, on which the normal presumption of verity might attach to the findings of the Trial Court under Rule 52(a), F.R.C.P., the issue of whether a particular patent meets the requisite standard of invention essential to validity is now generally regarded as a fully reviewable question of law, . . .”

This circuit is fully in accord at least where the evidence is before the appellate court in precisely the same form as it was in the lower court.

*Kwikset Locks, Inc. v. Hillgren* (9th Cir., 1954),  
210 F. 2d 483;

*Oriental Foods, Inc. v. Chun King Sales, Inc.* (9th  
Cir., 1957), 244 F. 2d 909.

#### 4. The Limited and Incomplete Record Before the Patent Office Examiner Resulted in Improper Allowance of the Patent in Suit.

A copy of the Leichter patent in suit appears at page 46 of the record. It was admitted as Exhibit 1 [R. 38]. As shown in Fig. 2 of the patent, the handle is generally of very simple shape. It has the following features:

1. It is a bar type pull.
2. It is generally rectangular as shown in Fig. 2, with sides bowing outwardly.
3. The handle is concave in transverse section.
4. It has a lens shaped cut-out in the central bar portion.
5. The pull has a downward arch as illustrated in Fig. 3.

There were two references and only two references that the Patent Office Examiner cited against the Leichter patent: Heyer, D 169,257 [R. 48] and Clayton D 180,684 [R. 49]. These patents were admitted as Exhibits 5 and 6 [R. 38]. See the certified file history of the Leichter patent, physical Exhibit M admitted in evidence [R. 43]. Samples of these pulls, the only two that the Patent Office Examiner deemed pertinent, or was able to find were admitted in evidence as physical Exhibits M-1 and M-2 [R. 44-45] to which reference is here made. These prior art pulls known to the Examiner had very little in common with the Leichter design, and in view of the limited and incomplete record there before him, the Examiner felt justified in allowing the Leichter patent.

Thus, as to the *Heyer* patent, Exhibit 5 [R. 48] and Exhibit M-1:

1. It is, true enough, made of bar metal.
2. It is clearly not of rectangular configuration. It is a half-circle.
3. The Heyer pull is, true enough, concave in transverse section.
4. There is no sort of opening at all in the Heyer pull, much less one corresponding to a lens shape.
5. There is no suggestion of longitudinal curvature whatsoever in the Heyer pull.

The similarities are clearly outweighed by the dissimilarities. There is hardly anything in common so far as overall appearance is concerned.

With respect to the Clayton patent, Exhibit 6 [R. 49] and Exhibit M-2:

1. It is not made of bar metal. It is made of a loop of rod-like material.
2. It is generally rectangular only in the very loose sense that it is longer than it is wide.
3. There is not the slightest possibility of the Clayton pull suggesting transverse curvature.
4. There is in Clayton a thin very long opening in the center, but this is formed not as a cut-out in bar metal. Instead it is formed as an incident to the fact that the face of the pull is simply a squashed or oblate loop of rod. The ends of the opening go beyond the mounting posts, unartfully revealing them.
5. Finally, there is a longitudinal arch in Clayton, but the longitudinal arch is up, not down!

In almost every point, the Clayton pull is unlike the Leichter pull. It falls far short of being pertinent.

5. **The Examiner Failed to Find the Most Pertinent References.**

Defendant filed Request for Supplemental Admissions [R. 64] which were admitted in evidence [R. 41]. These requests for supplemental admissions asked plaintiff to concede that certain Exhibits A, B, C, F, G, H, I, K and F-1 among others, were prior art. For example, Request for Admission No. 32 states:

“Defendant’s Exhibit A, lodged herein, exemplifies a pull known by others in this country before the alleged invention of the subject matter of Design Patent No. Des. 182,602 by Newton S. Leichter.”

If this statement is true, §102 of Title 35 of United States Code establishes such Exhibit A as prior art. Similar considerations apply to the remaining exhibits of this group. The Plaintiff’s Response to Second Supplemental Request for Admissions is printed in full between pages 67 and 79 of the record, and was received in evidence [R. 41]. It will be clearly noted that the plaintiff made *no answer* to Requests for Admissions Nos. 32, 33, 34, 37, 38, 39, 64 and 65. With respect to Request No. 66, defendant conceded that if a small catalog not 8½ x 11 was meant (which it was) the request was admitted. Exhibits A, B, C, F, G, H, I, K and F-1 were thus conceded to be prior art devices *that were unknown to the Patent Office Examiner.*

Exhibits A, B, C, F, G and H were received in evidence [R. 41]. Exhibit I was received in evidence [R. 41]. Exhibit K was received in evidence [R. 42]. Exhibit F-1 was admitted in evidence [R. 42].

Exhibits D and E-3 were admitted in open court to be prior art. In this connection attention is invited to the record at page 44, wherein counsel for plaintiff stated:

“Your Honor, if we are getting down to whether this 555 pull and the other one that the other witness was talking about were made and sold before ours, we will admit it, and it will save an awful lot of time.”

Exhibits D and E-3 were admitted in evidence [R. 44 and 45].

Although the court made no finding that the foregoing exhibits were prior art, and although a request for such finding was made, as shown in proposed Finding of Fact 9 [R. 23 and 24], there is no question but that these items are in fact prior art.

Door pulls and door knobs are designed and manufactured in great abundance. Among the various catalogs introduced at the trial, there is in this record physical Exhibits A-1 and F-1 to which reference is here made. These exhibits show many different pulls in various sizes and shapes. Without more, this court may properly conclude that no unusual or inventive talent is required to create a “new” knob or pull. The question with which this portion of the appeal is concerned is whether or not the plaintiff’s “new” pull designed by Newton S. Leichter in fact required the exercise of invention, or was unobvious or otherwise met the standards of patentability as set forth in §103 of Title 35 of the United States Code which provides:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth

in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

This section, of course, is directly applicable to design patents by virtue of the second paragraph of §171 of Title 35 of the United States Code, which provides:

“The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.”

The appellant singles out for discussion and comparison at this time physical Exhibit E-3, and a patent drawing of Exhibit E-3 to be found at page I of the Appendix hereto. The appellant invites a direct comparison between Exhibit E-3 and the patent in suit [R. 46]:

1. Exhibit E-3 like the patented pull is made of *bar* material.
2. Exhibit E-3 like the patented pull is generally *rectangular*.
3. Exhibit E-3 like the patented pull is *concave* in transverse section.
4. Exhibit E-3 like the patented pull has a *downward arch*.

Thus Exhibit E-3, unlike the references found by the Examiner, has four out of five points of similarity with the patented pull. The only element lacking is a lens shaped opening. Exhibit E-3 has an overall similarity in appearance to the patented pull whereas the Heyer and Clayton pulls have no such general similarity.

Next, the appellant draws attention to physical Exhibit H, and also to a patent drawing of Exhibit H to be found at page II of the Appendix hereto. Appellant invites a comparison with the patented pull [R. 46]. Exhibit H has striking similarities to the patented pull:

1. It is made of *bar* material.
2. Not only is it generally *rectangular*, but the sides of this pull *bow outwardly* as do the sides of the patented pull.
3. The handle is *concave* in transverse section.
4. The pull has a *downward arch* nearly identical to that of the patented pull.

Again, Exhibit H, unlike the references found by the Examiner, bears a similarity of features that certainly can be rated 80 or 90 percent. The only feature lacking in Exhibit H is a lens shaped opening. Exhibit H has an overall similarity in appearance to the patented pull not even remotely approached by the Heyer and Clayton pulls.

Just how unobvious would it be to provide a lens shaped opening in Exhibit E-3 or Exhibit H? The appellant contends that a routine designer of furniture or cabinet hardware could do just such thing *without invention*. That such lens shaped openings have been provided in bar type pulls, reference is here made to physical Exhibit F which shows such opening occupying the central area of a pull between its mounting posts. It isn't unusual or strange to place curved holes in a knob or pull. See physical Exhibit A, physical Exhibit G and physical Exhibit C a patent drawing of which appears at page III of the Appendix hereto.

It is earnestly submitted that an ordinary designer of furniture or cabinet hardware having before him Exhibits E-3, H and F, for example, could *without invention* and without requiring any *unusual talent*, place a hole in Exhibit H or Exhibit E-3. The structure thereby resulting would differ immaterially and insignificantly from the patented pull, and surely would preclude invention in the patented pull.

#### 6. Presumption of Validity Is Non-Existent.

Since the Examiner in the Patent Office failed to find the most pertinent references, the presumption of validity attaching to a patent under §282 of Title 35 no longer exists.

*Jacuzzi Bros., Inc. v. Berkeley Pump Co., et al.*  
(9th Cir., 1951), 191 F. 2d 632.

#### 7. Tests of Invention Are Strict.

A design *must* disclose inventive originality. Mere mechanical skill is no more sufficient to warrant the issuance of a design patent than the issuance of a mechanical patent.

*Thabet Manufacturing Company v. Kool Vent Metal Awning Corporation of America.* (6th Cir., 1955), 226 F. 2d 207.

A streamlined and pleasing appearance alone does not create patentability in the absence of invention. Thus in *Magarian v. Detroit Products Co.* (9th Cir., 1942), 128 F. 2d 544, this court stated at page 545:

“It may readily be conceded, as appellant contends, that the design of the arm is streamlined and pleasing



in appearance; but this is insufficient in the absence of invention. Walker on Patents (Deller's Edition), Vol. 1, §129, p. 421; A. C. Gilbert Co. v. Shemitz, 2 Cir., 45 F. 2d 98, 99; Berlinger v. Busch Jewelry Co., Inc., 2 Cir., 48 F. 2d 812, 813. There was no invention here. The outline of the arm is perhaps a refinement over prior structures shown in the record, but that is all that can be said for it. The oval shape of the lenses is disclosed in both the Reynolds and the Costenbader patents. The Elliott patent as well as appellant's own earlier structure suggested the flanges at the outer rim of the plates and the position of the rivets fastening the flanges together."

In *Moore et al. v. C. R. Anthony Co.* (10th Cir., 1952), 198 F. 2d 607, at page 609 the court stated:

"Just as a mechanical patent must be more than 'new and useful', so must a design patent be more than new, original and ornamental. Both must contain that indefinable genius of invention. See *Smith v. Whitman Saddle Co.*, 148 U. S. 674, 13 S. Ct. 768, 37 L. Ed. 606. The design must not only be new and pleasing enough to win acceptance in the market place, it must also distinctly add to the total knowledge of the particular field of design; it must be more than mere perfection of workmanship. *Associated Plastics Companies, Inc. v. Gits Molding Corp.*, 7 Cir., 182 F. 2d 1000; *Knickerbocker Plastic Co., Inc. v. Allied Molding Corp.*, 2 Cir., 184 F. 2d 652; *Application of Johnson*, 175 F. 2d 791, 36 C. C. P. A., Patents, 1175; *In re Faustmann*, 155 F. 2d 388, 33 C. P. A., Patents, 1065; Cf. *Shaffer v. Armer*, 10 Cir., 184 F. 2d 303."

In *Gold Seal Importers, Inc. v. Morris White Fashions, Inc.* (2nd Cir., 1941), 124 F. 2d 141, at page 142 the court stated:

“The question remains whether the rearrangement of old elements with such minor variations as were necessary to produce the plaintiff’s design involved some exceptional talent beyond the range of the ordinary designer. Each change in itself was simple: to make the shape more nearly oval, to deepen the folds on the front side and use a spiral rod for the central ornament, to duplicate the folds and ornament on the reverse side, to sink the mouth within the top edge and provide a zipper for closing. No one of these things would seem to involve exceptional talent beyond the skill of a designer. Whether the conception of a design combining all these changes into a unitary and pleasing whole requires a flash of ‘inventive genius’ rather than routine designing no formula can determine. In final analysis it depends upon the judgment of the judge or judges who have the last say. In our opinion Judge Galston was correct in ruling that the development of the patented design ‘required nothing more than ordinary skill rather than creative art.’ [38 F. Supp. 892].”

In *General Time Instruments Corporation v. United States Time Corporation* (2nd Cir., 1948), 165 F. 2d 853, at page 854 the court stated:

“It is well settled that a design patent must be the product of invention if it is to be valid. *Neufeld-Furst & Co. v. Jay-Day Frocks*, 2 Cir., 112 F. 2d

715; *In re Griffith*, Cust. & Pat. App., 86 F. 2d 405. It will not suffice merely to show that the design is novel, ornamental, or pleasing in appearance. *Gold Seal Importers v. Morris White Fashions*, 2 Cir., 124 F. 2d 141. It must reveal a greater skill than that exercised by the ordinary designer who is chargeable with knowledge of the prior art. *Zangerle & Peterson Co. v. Venice Furniture Novelty Mfg. Co.*, 7 Cir., 133 F. 2d 266; *In re Eppinger*, Cust. & Pat. App., 94 F. 2d 401. In short, the test is whether the design involved 'a step beyond the prior art requiring what is termed "inventive genius."' *A. C. Gilbert Co. v. Shemitz*, 2 Cir., 45 F. 2d 98, 99. So measured, plaintiff's patent must fail. Here there is no inventive skill. No more is shown than the modification and combination of existing clock designs to produce the one at issue. The changes are too slight to disclose the requisite originality and invention necessary to sustain a patent. *Knapp v. Will & Baumer Co.*, 2 Cir., 273 F. 380. This is the talent of the adapter, rather than the art of the inventor. The patent was therefore properly held invalid."

In *Knickerbocker Plastic Co., Inc. v. Allied Molding Corp.* (2nd Cir., 1950), 184 F. 2d 652, at page 654 the court stated:

"So our court has held that 'a design patent must be the product of "invention," by which we meant the same exceptional talent that is required for a mechanical patent.' *Nat Lewis Purses, Inc., v. Carole Bags, Inc.* 2 Cir., 83 F. 2d 475, 476. See also

Friedley-Voshardt Co. v. Reliance Metal Spinning Co., D. C. S. D. N. Y., 238 F. 800, 801. Thus it is now too late to urge that an unstartling regrouping of old elements, which does not 'rise above the commonplace' or demonstrate 'originality which is born of the inventive faculty,' may be called 'invention' for the purposes of patent validity."

### 8. Commercial Success Does Not Weigh in Favor of the Patent.

Both plaintiff and defendant are in the hardware business and both sell substantial volumes of builders' hardware. It having been shown that plaintiff sold a volume of patented pulls, the District Court found in its Finding of Fact No. 4 [R. 31] that the plaintiff "has achieved commercial success." There is nothing in this record on appeal to show that this commercial success was in anyway unusual. There is nothing in this record to show that the patented pulls displaced any others. There is nothing in this record to show that this commercial success was immediate.

In any event commercial success is not and cannot be a substitute for invention. It cannot covert commonplace skill into invention.

*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. et al.*, 340 U. S. 147.

### 9. Application of the Rules Negates Patentability and Compels a Holding of Invalidity.

The drawer pull involved here is just another variant of a bar type pull. No element in it is new. It merely combines old features already known to the bar pull art. The design is not startling or unusual. A designer of

bar pulls certainly could be expected to put ornamental holes in pulls such as physical Exhibit E-3 or Exhibit H and as suggested by physical Exhibits A, C or G.

### CONCLUSION.

In conclusion, the language of Justice Bradley in *Atlantic Works v. Brady*, 107 U. S. 192, and cited with approval by this court in *Oriental Foods, Inc. v. Chun King Sales, Inc.*, *supra*, is particularly appropriate:

“It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.”

The judgment of the District Court should be reversed on the issue of validity and the injunction sought should be granted.

Respectfully submitted,

FLAM AND FLAM,

By FREDERICK FLAM,

*Attorneys for Defendant-Appellant.*









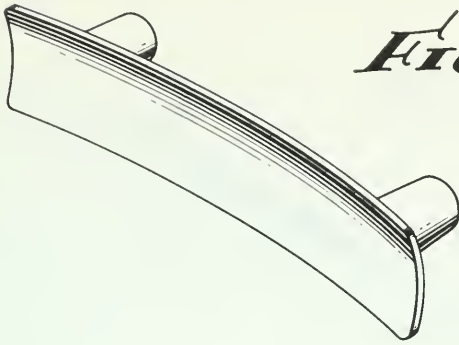


FIG. 1.

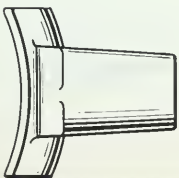
FIG. 2.



FIG. 3.

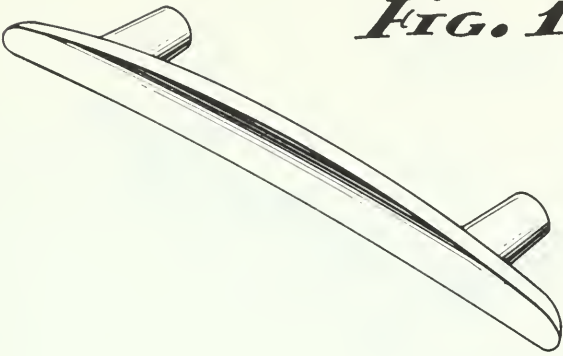


FIG. 4.





*FIG. 1.*



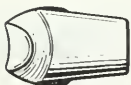
*FIG. 2.*



*FIG. 3.*

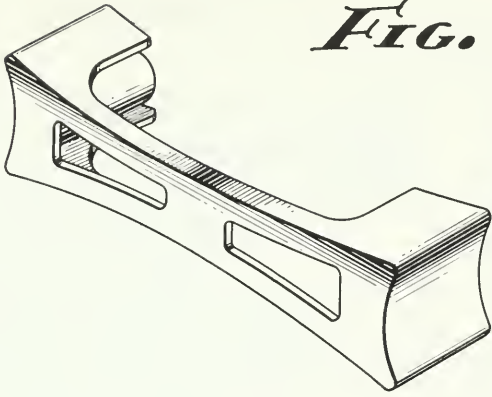


*FIG. 4.*

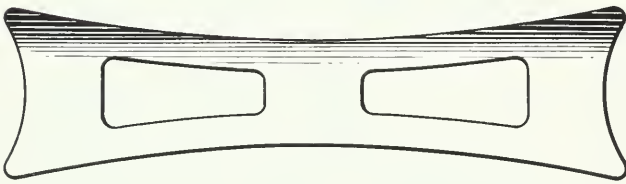




*FIG. 1.*



*FIG. 2.*



*FIG. 3.*



*FIG. 4.*





## APPENDIX IV.

EXHIBIT		Record Page
1	Leichter Design Patent No. 182,602	38
5	Heyer Design Patent No. 169,357	38
6	Clayton Design Patent No. 180,684	38
A	Bassick-Sack Pull No. 9543	41
A-1	Bassick-Sack Catalog	42
B	Bassick-Sack Pull No. 9471	41
C	Bassick-Sack Pull No. 9459	41
D	Jaybee Pull No. 555	44
E-3	Jaybee Pull No. 573	45
F	Faultless Pull No. 941	41
F-1	Faultless Catalog of 1956, pages 5 and 10	42
G	Faultless Pull No. 960	41
H	Faultless Pull No. 1042	41
I	Furniture for Modern Interiors by Mario del Fabbro, page 98	41
K	Widdicomb Bench	42
M	Certified file history of Leichter patent	43
M-1	Clayton model	44
M-2	Heyer model	45
N-1	Ajax letter to Crest Hardware	40
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P-1	Request for Admissions	41
P-2	Response to Request for Admissions	41
P-3	Request for Supplemental Admis- sions	41
P-4	Response to Supplemental Admis- sions	41
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